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09/557,617	04/25/2000	Thomas G. Woolston	11092-005002	9094

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EXAMINER

SNAPP, SANDRA S

ART UNIT PAPER NUMBER

3624

DATE MAILED: 03/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/557,617

Applicant(s)

WOOLSTON, THOMAS G.

Examiner

Sandra Snapp

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 19-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Supplemental Action***

This Supplemental Office Action is a supplement to the Office Action mailed 2-24-04. The previous Office Action of 2-24-04 was made final. The finality of the previous action is herein withdrawn. This Supplemental Office Action is non-final.

***Claim Rejections - 35 USC § 101***

Claims 19-21 were amended to include a reference to include a computer in the preamble. Further review of the claims identified a database in the body of the claim. Therefore the rejection of claims 19-21 based on 35 U.S.C. 101 is herein withdrawn. Also, with regard to claim 22, which was not previously rejected, the claim states ‘one or more processes executing on the computer system’ of which the Examiner is taking the position that with such processes, there must inherently be software embedded in the computer for executing such processes.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 19, 21, 22 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by the Shavit et al. patent (US 4,799,156). This rejection is repeated from the Office Action dated 2-24-04 and is non-final.

The Shavit patent discloses a system for facilitating electronic commerce transactions comprising:

A means for interfacing a plurality of Internet users (col. 5, lines 39-62), an accounts database for maintaining accounts (col. 7, lines 23-26), a means for tracking account information for the plurality of Internet users (col. 7, lines 23-46 and col. 9, lines 16-19), means for deducting a payment amount from an Internet user's account corresponding to an accepted offer made by that Internet user to purchase one or more goods offered for sale by a third-party seller (col. 8, lines 55-68), and means for transferring the deducted payment amount to an account associated with the third-party who accepted the Internet user's offer to purchase the third-party's one or more goods (col. 8, line 55 through col. 9, line 6) (claim 19);

Means for receiving offers from the plurality of Internet users (col. 6, lines 36-51), and means for associating the offers from the plurality of Internet users with the account information (col. 8, lines 30-41) (claim 21);

A computer system in communication with the Internet and capable of executing a plurality of substantially simultaneous processes (col. 6, lines 52-56), and one or more processes executing on the computer system to maintain an accounts database (col. 7, lines 23-26), to deduct a payment amount from the Internet User's account corresponding to an accepted offer made by that Internet user to purchase one or more goods or collectibles offered for sale by a third-party seller (col. 8, lines 55-68), and to transfer the deducted payment amount to an account

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associated with the third-party who accepted the Internet user's offer to purchase the third party's one or more goods or collectibles (col. 8, line 55 through col. 9, line 6) (claim 22); and

providing via the Internet a user interface for participants to select from a predetermined item category (col. 10, lines 45-57), the category selection providing a further predetermined sub-category selection for item categorization (col. 10, lines 45-57), providing a selling mode selection between at least an ascending bid auction mode and a fixed price mode (col. 13, lines 35-58), and providing a unique identification code or number for each item posted by a participant seller in the system (col. 12, line 63 through col. 13, line 9) (claim 23).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 20 and 24-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Shavitz patent as applied to claims 19 and 22 above, and further in view of the Grant patent.

With regard to claim 20, the Shavit patent discloses all the elements of the claimed invention except for the interest returned on the account is paid at least in part from investment returns from US treasury notes. The Grant patent teaches the interest returned on the account as being paid at least in part from investment returns from US treasury notes (Grant, col. 9, lines 2-17) (claim 20). It would have been obvious to one of ordinary skill in the art at the time the

invention was made to have modified the Shavit system with the teachings of the Grant reference so as to provide the users of the financial aspects of the system an incentive to keep money available to the system by keeping money in their account whereby it would draw interest until used.

With regard to claim 24, Shavits discloses a system having:

A communications interface for communicating with at least a buyer participant and a seller participant via the Internet (Shavit, col. 5, lines 39-47), a transaction processor for processing electronic commerce transactions (Shavit, col. 8, lines 55-68), an accounts database operably connected via the transaction processor to the communication interface (Shavit, col. 7, lines 23-26), the accounts database having a plurality of participant accounts including a buyer participant account and a seller participant account (Shavit, col. 8, lines 55-68), and the transaction processor operatively connected to the communications interface and the accounts database (Shavit, col. 8, lines 55-68), wherein the transaction processor is responsive to a command from the buyer participant to accept an offer for sale of an item posted by the seller participant and, in response to said command, the transaction processor transfers funds accounted for in the accounts database from the buyer participant account to the seller participant account by book entry transaction (Shavit, col. 8, line 55 through col. 9, line 6).

The Shavit patent lacks an apparatus providing interest-bearing accounting for positive balances in the participant accounts. The Grant patent teaches the apparatus providing interest-bearing accounting for positive balances in the participant accounts (Grant, col. 9, lines 2-17) (claim 24). It would have been obvious to one of ordinary skill in the art at the time the

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invention was made to have modified the Shavit patent with the teachings of the Grant patent so as to provide the users of the financial aspects of the system an incentive to keep money available to the system by keeping money in their account whereby it would draw interest until used.

With regard to claims 25-28, the Shavit patent discloses an apparatus for facilitating electronic commerce transactions comprising:

The positive account balance in the buyer participant account results from one or more of the following: proceeds from a past sale of at least one item posted for sale; and from the transfer of funds to the first user account (the buyer) from a financial institution associated with the first user (the buyer) (Shavit, col. 8, line 55 through col. 9, line 19) (claim 25);

The positive account balance for the seller participant account is cleared by one or more of the following: a check printed and made paid to the order of the seller participant; and by electronic fund transfer from a financial institution associated with the system to a financial institution associated with the seller participant (Shavit, col. 8, line 55 through col. 9, line 6) (claim 26);

Credit card processing fees are eliminated by use of positive available balances of the user accounts in the buying and selling of collectable goods via the transaction processor transferring accounting balances between the accounts maintained in the accounts database (Shavit, col. 8, line 55 through col. 9, line 6) (claim 27);

the buyer participant accepting the offer for sale from the seller participant, wherein the seller participant previously purchased the item as a network participant in the apparatus for

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facilitating electronic commerce and the buyer participant commands the transaction processor to clear the purchase by book entry transaction between the buyer participant account and the seller participant account (col. 11, lines 22-35) (claim 28).

With regard to claims 29-30, the Shavit patent lacks: means for returning interest on positive balances in the accounts of the plurality of Internet user (claim 29); and one or more processes to return interest on positive balances maintained in the user accounts (claim 30).

The Grant patent teaches: means for returning interest on positive balances in the accounts of the plurality of Internet users (Grant, col. 9, lines 2-17) (claim 29), and one or more processes to return interest on positive balances maintained in the user accounts (Grant, col. 9, lines 2-17) (claim 30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Shavit patent with the teaching of the Grant patent so as to provide the users of the financial aspects of the system an incentive to keep money available to the system by keeping money in their account whereby it would draw interest until used.

### ***Response to Arguments***

Applicant's arguments with respect to claims 19-28 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***



Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra Snapp whose telephone number is 703-305-6940. The examiner can normally be reached on Mon.-Thurs..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1065. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

SS

*Sandra Snapp*  
SANDRA S. SNAPP  
PATENT EXAMINER  
GROUP 3600